

REMARKS

Claims 1-19 are pending and stand rejected. In light of the following remarks, Applicants respectfully request reconsideration and allowance of claims 1-19.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1-19 under 35 U.S.C. § 103(a), alleging that they are unpatentable over the Perlman patent (U.S. Patent No. 5,225,165). The Examiner cited MPEP § 2144.04(VI)(C), and alleged that it would have been obvious to relocate the flange of the microtube described in the Perlman reference, “since it has been held that rearranging parts of an invention involves only routine skill in the art.” (Office Action at pages 3 and 5.)

Applicants respectfully disagree. As the Supreme Court recently clarified, obviousness under § 103 requires consideration of the factors set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), including an analysis of the scope and content of the prior art and the differences between the claimed subject matter and the prior art. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). Moreover, and importantly, an *explicit rationale* for why one having ordinary skill in the art would have combined the elements in the manner claimed must be set forth. *Id.* at 418. In the present case, the Examiner has failed to set forth an explicit rationale as to why a person of ordinary skill in the art would have found it obvious to rearrange the microtube of the Perlman patent.

Applicants submit that a person having ordinary skill in the art upon reading the Perlman patent would not have been motivated to rearrange the microtube disclosed therein. At no point does the Perlman patent teach or suggest either a flange positioned within the half of the lid proximal to the hinge, as recited in present claims 1 and 16, or a flange that moves toward the closed end of the tube upon the application of mechanical force to the flange, as recited in present claim 1. To the contrary, the Perlman patent discloses a lid extension that is “attached within the half of the lid distal from the hinge.” See, column 3, lines 10-12, and column 6, lines 17-20 and 45-47. The Perlman patent further discloses that in the preferred arrangement, the lid extension is “on or near the original lifting tab and relatively far from the hinge,” which

increases leverage and facilitates opening of the microtube. See column 3, lines 12-16, and column 6, lines 47-50. Given the Perlman patent's express preference for such placement of the lid extension, a person having ordinary skill in the art would have had no motivation to relocate the extension.

To bridge the gap between the Perlman patent and the present claims, the Examiner asserted that relocation of the Perlman flange on the lid would have been an obvious rearrangement of parts of the invention. (Office Action at page 3.) The Examiner's assertion is not sufficient where, as here, there is no teaching or suggestion in the cited reference that would motivate a person having ordinary skill in the art to relocate the flange in that manner.

The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device.

Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984; emphasis added). Without any motivation or reason for one having ordinary skill in the art to make the necessary rearrangements, the present claims are not obvious over the Perlman patent.

Applicants further submit that it is improper to reject the present claims as obvious when the specifically recited limitation is a critical feature of the present invention and not merely a "design choice." Provision of a flange extending outwardly, wherein the flange is positioned within the half of the lid proximal to the hinge and is arranged to move towards the closed end of the container upon application of a mechanical force to a surface of the flange, is not a simple matter of design choice. The benefits of positioning the flange in the half of the lid proximal to the hinge are at least two-fold: the lid provides a physical barrier such that, when applying pressure, the flange does not come into contact with the tube contents, and the tube can be opened more easily with an outward and downward circular motion. (See, e.g., Applicants' specification at page 4, lines 12-15 and 19-23, and page 5, lines 10-12.) Since the specific limitation is critical to the present invention, the Examiner cannot rely solely on case law regarding allegedly "routine expedients" or common design choices as the rationale to support an obviousness rejection. MPEP § 2144.04.

Applicant : Roy Garvin et al.
Serial No. : 10/525,127
Filed : April 5, 2006
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In light of the above, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-19 under 35 U.S.C. § 103.

CONCLUSION

Applicants submit that claims 1-19 are in condition for allowance, which action is respectfully requested. The Examiner is invited to telephone the undersigned agent if such would further prosecution.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: July 31, 2009/

/Elizabeth N. Kaytor/
Elizabeth N. Kaytor, Ph.D.
Reg. No. 53,103

Fish & Richardson P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis, Minnesota 55402
Telephone: (612) 335-5070
Facsimile: (877) 769-7945